## REMARKS

The Response

*Rejection under 35 U.S.C. § 102(b)*

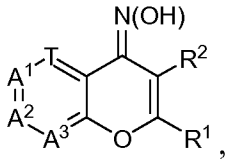
The Examiner has stated in the Office Action Summary and in the Detailed Action that claim 50 is rejected under 35 U.S.C. § 102(b). However, this appears to be new grounds for rejection since claim 50 was rejected only under 35 U.S.C. § 112, second paragraph, in the August 13, 2008 Office Action (hereafter, "the August Office Action") and this rejection has been withdrawn in the instant Final Office Action. Applicants would like clarification on this issue.

The Examiner has also rejected claims 47, 81, 83, 87, 92, and 96 under 35 U.S.C. § 102(b) for allegedly being anticipated by Meshcheryakova et al., *Khimiko-Farmatsevticheskii Zhurnal* 10(3), 37-41, 1976 (hereafter, "Meshcheryakova 1"); Meshcheryakova et al., *Khimiko-Farmatsevticheskii Zhurnal* 12(4), 50-54, 1978 (hereafter, "Meshcheryakova 2"); and Basinski et al., Polish Journal of Chemistry 65(9-10, 1619-1632, 1991 (hereafter, "Basinski"). In particular, the Examiner asserts that Meshcheryakova 1 and Meshcheryakova 2 teach the pharmaceutical compositions of the invention because these references describe oximes that fall within the scope of formula I and also describe oxime ethers derived from said oximes, wherein said oxime ethers are useful as sedatives. The Examiner also asserts that Basinski teaches the pharmaceutical compositions of the invention because certain compounds of Basinski fall within the scope of formula **I**. The Examiner further asserts that the term "pharmaceutical composition" in claim 47 is a preamble that is not accorded any patentable weight because it merely recites the intended use of a structure, since the body of the claim does not depend on the preamble for completeness [citations omitted]. Applicants traverse.

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. "A claim is anticipated only if

each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also the Manual of Patent Examining Procedure (MPEP) § 2131.

Claim 47 of the instant invention and those claims dependent thereon recite a pharmaceutical composition comprising an oxime of formula **I**:




or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier, adjuvant, or vehicle. In replying to the August Office Action, applicants showed that the pharmaceutically useful oxime ethers of Meshcheryakova 1 and Meshcheryakova 2 fall outside of the scope of the recited oximes of formula **I**. Applicants also asserted in the reply to the August Office Action that these two references do not provide any pharmaceutical utility for the oxime precursors used to prepare said oxime ethers nor do they describe or propose pharmaceutical compositions comprising said oximes. Applicants further asserted that Basinski also fails to describe oximes falling within the scope of formula **I** that possess pharmaceutical activity or that are used as part of a pharmaceutical composition. The Examiner has not presented any evidence to counter applicant's statements.

In addition, the Examiner has not presented any extrinsic evidence which makes it clear that the oximes of Meshcheryakova 1, Meshcheryakova 2, or Basinski that fall within the scope of formula **I** would be necessarily present in a pharmaceutical composition or would be so recognized by persons of ordinary skill in the art. "Inherent anticipation may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See the

Manual of Patent Examining Procedure (MPEP) § 2112 IV. The Examiner asserts that the term 'pharmaceutical composition' should be afforded no patentable weight but does not recognize the entire body of the claimed subject matter: a pharmaceutical composition comprising a compound of formula **I** and a pharmaceutically acceptable carrier, adjuvant, or vehicle.

Prior art describing compounds that fall within the scope of generic formula **I** of the instant invention without teaching, either expressly or inherently, the additional elements set forth in the claim (i.e., a pharmaceutically acceptable carrier, adjuvant, or vehicle) is not sufficient to anticipate the present invention. Therefore, applicants respectfully request that the rejection of claims 47, 81, 83, 87, 92, and 96 under 35 U.S.C. § 102(b) be withdrawn.

Conclusion

Applicants request that the Examiner consider the remarks herein and allow claims 47, 50, 81, 83-85, 87-89, 92-94, 96-98, and 101 to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the undersigned be contacted at the Examiner's convenience.

Respectfully submitted,

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